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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/354,161      | 07/16/1999  | ALAIN PENDERS        | Q55099              | 4708             |

7590                  09/17/2003

SUGHRUE MION ZINN MACPEAK & SEAS PLLC  
2100 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 200373213

[REDACTED] EXAMINER

ARANI, TAGHI T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2131     | 9            |

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/354,161             | PENDERS, ALAIN      |
| <b>Examiner</b>              | <b>Art Unit</b>        |                     |
| Taghi T. Arani               | 2131                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
  - 2a) This action is **FINAL**.      2b) This action is non-final.
  - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-11 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) 1-3 and 7-11 is/are rejected.
  - 7) Claim(s) 4-6 is/are objected to.
  - 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____                                     |

## DETAILED ACTION

**Claims 1-11 were pending for examination.**

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3,7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Apperson et al, U.S. Pat. No. 5,978,484, filed April 1996.

**As per claims 1, 9-11,** Apperson is directed to a system and method for distributing and executing an executable code wherein before sending executable codes to a client (i.e. a terminal), a distributing authority (i.e. a service provider) associates a privilege request code (i.e. predefined functionality) with the executable code, see abstract. The privilege request code indicates a requested set of privileges that the executable code will potentially exercise during execution.

Apperson teaches that the distributing authority digitally signs the executable code and the privilege request code, and also provides a certificate that can be traced by the client to a known certifying authority (CA), see col. 2, lines 40-53.

Apperson further teaches that each certificate indicates an authorized set of privileges that the holder of certificate is authorized to pass on to lower members of the hierarchy and that when a distributing authority distributes actual executable code, the associated privilege request code must indicate a subset of the privileges indicated by the privilege authorization code of the certificate held by the distributing authority, see col. 2, lines 61-67. That is to say, the distributed executable code (or predefined functionality) is part of the privileges indicated and held by the privilege authorization code (i.e. global functionality).

**As per claim 2,** Apperson teaches that the structure of hierarchy resembles a tree structure (tree-like) with a “root” member at the top connected to lower “leaf” members by “branch”.

Apperson further teaches that the root CA has authority over all possible privileges that an executable object might potentially exercise and that beneath the root are plurality of distributing authorities to distribute code with a particular privilege request code, see col. 5, lines 36-67.

Apperson further teaches that when a client computer (i.e. a terminal T) receives an executable object from a distributing authority DA3, the executable object is signed by DA3 and that the distributing authority DA3 receives its privilege authorization code from a certifying authority CA2. DA3’s privilege authorization code is a subset of CA2’s

privilege authorization code. The CA1's receives its privilege authorization code from the root certifying authority which has all possible privileges that might be exercised by executable objects, see col. 6, lines 16-29, see also Fig. 3.

**As per claim 3 and 8,** Apperson teaches that the client computer (i.e. a terminal T) performs a step of verifying that each particular certificate's indicated authorized set of privileges is a subset of the authorized set of privileges indicated in the digital certificate of the next-higher member of the hierarchy that digitally signed the particular certificate, see col. 8, line 65 through line 9 line 10.

Apperson further teaches a decision block indicating the action taken as a result of the verification steps performed by the client computer which involves preventing the executable code from exercising any privileges that are not in the requested set of privileges indicated by the privilege request code, see col. 9, lines 11-29.

**As per claim 7,** Apperson teaches that credentials associated with the server computer or distributing authority include s privilege authorization code indicating which privileges or privilege classes are allowed to be exercised by code distributed from server or another distributing authority, see col. 4, lines 55-65. Apperson further teaches that the credentials are issued to server or to the distributing authority by one or more certifying authorities and are digitally signed by the certifying authorities and that the certifying authorities are responsible for verifying the trustworthiness of the distributing authority (i.e. service providers) and that the certifying authorities determine which privileges any particular distributing authority should be allowed (or entitled) to authorize, see col. 4, line 66 through col. 6, line10.

**As per claim 9,** Apperson's invention includes a first step of establishing a hierarchy of authorities comprising a plurality of certifying authorities and a plurality of distributing authorities (i.e. service providers), see col. 7, lines 35-42. the members of the hierarchy are connected for communications over a network or other communications medium.

Apperson teaches assigning a privilege authorization code to each member of the hierarchy. The privilege authorization code indicates a set of privileges that a particular member (such as distributing authority or service provider) is authorized to incorporate in executable objects provided from one member for execution on other computers, see col. 7, lines 43-66, col. 8, lines 9-16. Apperson further teaches that the privilege authorization code indicates maximum set of privileges that member can include in the assigned privilege authorization codes of other, lower members of hierarchy.

Apperson teaches that the distributing authority (i.e. service provider) creates an executable code and optional data with a privilege request code associated with the executable code. The privilege request code indicates a requested set of privileges that the executable code will potentially exercise on a client computer, see col. 8, lines 1-16. the requested set of privileges is a subset of the authorized set of privileges indicated the distributing authority's credentials.

#### *Allowable Subject Matter*

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from examiner should be directed to Taghi Arani, whose telephone number is (703) 305-4274. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The Fax numbers for the organization where this application is assigned are:

After-final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7240

Taghi Arani

Patent Examiner

September 11, 2003

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100